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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,623	12/21/2001	Ronald V. Swanson	09010-105004	9858
25225	7590	07/01/2004	EXAMINER	
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			FIELD, TAMMY K	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/034,623

Applicant(s)

SWANSON ET AL.

Examiner

Tammy K. Field

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 6, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 6 classified in class 530, subclass 387.9.
  - II. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 10, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 10 classified in class 530, subclass 387.9.
  - III. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 14, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 14 classified in class 530, subclass 387.9. Claim 1-2 (in part), drawn to an isolated or purified antibody of SEQ ID NO: 26, classified in class 530, subclass 387.9.
  - IV. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 26, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 26 classified in class 530, subclass 387.9.
  - V. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 28, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 28 classified in class 530, subclass 387.9.

Art Unit: 1645

- VI. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 30, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 30 classified in class 530, subclass 387.9.
- VII. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 32, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 32 classified in class 530, subclass 387.9.
- VIII. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 34, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 34 classified in class 530, subclass 387.9.
- IX. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 38, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 38 classified in class 530, subclass 387.9.
- X. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 42, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 42 classified in class 530, subclass 387.9.
- XI. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 46, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 46 classified in class 530, subclass 387.9.

- XII. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 58, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 58 classified in class 530, subclass 387.9.
- XIII. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 60, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 60 classified in class 530, subclass 387.9.
- XIV. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 62, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 62 classified in class 530, subclass 387.9.
- XV. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 64, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 64 classified in class 530, subclass 387.9.
- XVI. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 66, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 66 classified in class 530, subclass 387.9.
- XVII. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 68, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 68 classified in class 530, subclass 387.9.

Art Unit: 1645

- XVIII. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 72, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 72 classified in class 530, subclass 387.9.
- XIX. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 76, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 76 classified in class 530, subclass 387.9.
- XX. Claim 1-2 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 80, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 80 classified in class 530, subclass 387.9.
- XXI. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 4, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 4 classified in class 530, subclass 387.9.
- XXII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 8, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 8 classified in class 530, subclass 387.9.
- XXIII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 12, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 12 classified in class 530, subclass 387.9.
- XXIV. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 16, and antibody capable of binding to at least 10

Art Unit: 1645

consecutive amino acids of SEQ ID NO: 16 classified in class 530, subclass

387.9.

XXV. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 18, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 18 classified in class 530, subclass

387.9.

XXVI. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 20, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 20 classified in class 530, subclass

387.9.

XXVII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 22, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 22 classified in class 530, subclass

387.9.

XXVIII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 24, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 24 classified in class 530, subclass

387.9.

XXIX. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 36, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 36 classified in class 530, subclass

387.9.

XXX. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 40, and antibody capable of binding to at least 10

consecutive amino acids of SEQ ID NO: 40 classified in class 530, subclass 387.9.

- XXXI. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 44, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 44 classified in class 530, subclass 387.9.
- XXXII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 48, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 48 classified in class 530, subclass 387.9.
- XXXIII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 50, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 50 classified in class 530, subclass 387.9.
- XXXIV. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 52, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 52 classified in class 530, subclass 387.9.
- XXXV. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 54, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 54 classified in class 530, subclass 387.9.
- XXXVI. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 56, and antibody capable of binding to at least 10



Art Unit: 1645

consecutive amino acids of SEQ ID NO: 56 classified in class 530, subclass

387.9.

XXXVII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 70, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 70 classified in class 530, subclass 387.9.

XXXVIII. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 74, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 74 classified in class 530, subclass 387.9.

XXXIX. Claim 3-4 (in part), drawn to an isolated or purified antibody capable of binding to a polypeptide of SEQ ID NO: 78, and antibody capable of binding to at least 10 consecutive amino acids of SEQ ID NO: 78 classified in class 530, subclass 387.9.

The inventions are distinct, each from the other because of the following reasons:

2. The products are distinct from each other as claimed because they are made of different antibodies that bind to different amino acid sequence structures. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case the different inventions (I - XXXIX) are antibodies that bind to different amino acid sequences and therefore each antibody would have a different effectual response to each of the disclosed polypeptide SEQ ID NOs. In the instant case the antibodies can be alternatively used in materially different methods such as purification of a protein. As such, the products are distinct each from other.

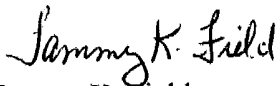
3. These inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification and in the absence of restriction would place an undue burden on the examiner, restriction for examination purposes as indicated is proper.
4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examiner even though the requirement be traversed (27 CFR 1.143).
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammy K. Field whose telephone number is (571) 272-0856. The examiner can normally be reached on Monday-Friday from 7am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached at (571) 272- 0864.

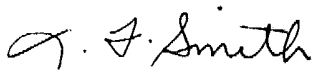
Papers relating to this application may be submitted to Technology Center 1600 Group 1640 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and After Final communications.

Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tammy K. Field  
June 28, 2004



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